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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,312	11/06/2003	Yoshinori Sekine	F-8028	8003
28107	7590	12/21/2005	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			DICUS, TAMRA	
		ART UNIT		PAPER NUMBER
				1774

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/702,312	SEKINE, YOSHINORI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## **DETAILED ACTION**

The Examiner acknowledges cancellation of claims 13-16.

### ***Claim Objections***

1. Claim 2 recites “the resin component a crosslinked polyester”, which appears grammatically incorrect. Appropriate correction is required.
2. Claims 3-4, 7-12 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3-4 and 7-12.

Claims 3 and 4 appear to be the same as they are dependent upon claim 1 as claim 1 contains the binder.

Claims 7 and 8; 9 and 10; and 11 and 12 appear to be the same as they are dependent upon claim 1 as claim 1 contains the binder.

3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a binder layer that is printed (which means normally containing a color) however Claims 7-12 state the binder layer has transparency. It is not clear if the binder layer is colored or transparent.

Further claim 1 recites a binder layer printed on the thermosoftening decorative print layer by use of a low/non-crosslinking printing ink. It is not clear which layer contains the low/non-crosslinking ink because the language “by use of” it is unclear where the ink is located.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,733,870 to Enlow et al. in view of JP 2001164163 to Ito.

Enlow teaches a paint film in this order: clear coat (61, FIG. 6 and associated text, col. 28, lines 34-53), color coats (62, FIG. 6 and associated text and col. 35-36) of binders including polyurethane, acrylic, PMMA, and fluoropolymers and blends thereof printed using gravure printing (col. 8, lines 15-25, instant claims 5-6) (no use of a crosslinking agent) and resin injected molded on the binder (size coat of PVC or PMMA) col. 12, lines 15-36, col. 31, lines 25-33 and col. 35, lines 30-col. 36, line 68 to form the finished laminate in automotive films (print films). Both coats 61 and 62 contain pigments and are thus considered ink. PMMA is inherently a transparent material and thus has transparency (claims 7-12).

Enlow does not teach a crosslinking printing ink layer or its composition (claims 1 and 2).

Ito teaches in this order: clear film (4), printing reflecting layer (3), black printing layer (2), where the ink for the printing layers is a crosslinked printing ink of polyurethane, polyester and acrylic resin with Isocyanate as the crosslinker (claim 2) to make the printing speed quick used as a mold ink in a paint film (0009-0018, 0014, 0021).

It would have been obvious to one having ordinary skill in the art to have modified the insert molded paint film of Enlow to incorporate a crosslink printing ink layer of polyurethane and acrylic because Ito teaches the ink using crosslinking agent in adjacent layers to make the printing speed quick used as a mold ink in a paint film and to further add aesthetical metallic appearance (0009-0018, 0014, 0021 of Ito).

That the binder is printed on the decorative print layer and that a resin is molded by injection are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

To claims 3-4, because there is no crosslinking agent used in Enlow's color coats, it is considered to have a lower degree as than the crosslinking agent used in Ito. Further, changing the amount of crosslinking agent to effect printing rates is a result effective variable and as such

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is optimizable. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

December 5, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 10/1/05